ESTTA Tracking number: **ESTTA770345**

Filing date: **09/13/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86321169
Applicant	Volcano Produce, Inc.
Applied for Mark	GOLDENBERRY
Correspondence Address	IRA COHEN HENKEL & COHEN P A 18001 OLD CUTLER RD STE 600 MIAMI, FL 33157-6444 UNITED STATES ic@miamibusinesslitigators.com
Submission	Reply Brief
Attachments	SKM_C654e16091316080.pdf(368363 bytes)
Filer's Name	Ira Cohen, Esq.
Filer's e-mail	ic@miamibusinesslitigators.com
Signature	/s/ Ira Cohen
Date	09/13/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Serial No.	86321169
Mark:	GOLDENBERRY
Applicant:	VOLCANO PRODUCE, INC.
Examining Attorney:	Michael Eisnach Law Office 104

EX PARTE APPEAL

APPLICANT'S REPLY BRIEF

Dated: Miami, FL
September 13, 2016

Ira Cohen, Esq.
HENKEL & COHEN, P.A.
Counsel for Applicant,
Volcano Produce, Inc.,
a Nevada corporation
18001 Old Cutler Road, Suite 600
Miami, FL 33157
Telephone (305)971-9474
Facsimile (305)971-9479

INTRODUCTION

COMES NOW, the Applicant, Volcano Produce, Inc., a Nevada corporation, with a business address in Valencia, California ("Applicant"), by and through its undersigned counsel, to hereby respectfully submit its Reply Brief in support of its appeal of the Examining Attorney's refusal to register the Applicant's word mark, GOLDENBERRY, Application Serial No. 86321169, filed June 26, 2014, in Class 31, for fresh fruits.

The literal element of the mark consists of the word GOLDENBERRY. The mark consists of standard characters, without claim to any particular font, style, size, or color.

A Request for Oral Hearing has been previously, and timely, filed on behalf of the Applicant, Volcano Produce, Inc.

PROCEDURAL HISTORY

The instant appeal was lodged and instituted on May 13, 2016. Applicant's main Brief was thereafter seasonably filed on July 8, 2016. Contemporaneously therewith, on July 8, 2016, Applicant filed its Request for Oral Hearing. The Examiner's Statement (Brief) was filed on August 25, 2016.

(II.) ISSUE ON APPEAL

On this appeal, the solitary issue presented may fairly be articulated as follows: Whether the Applicant's mark, GOLDENBERRY, is merely descriptive of the goods (*i.e.,* fresh fruits) under Section 2(e)(1) of the Trademark Act *vel non*?

Inasmuch as the Examining Attorney now has clearly and unequivocally represented to the Trademark Trial and Appeal Board (the "Board") that genericness is not an alternative ground for his refusal *vis-à-vis* this applied-for mark, little supererogation here is warranted.[1]

(III.) ARGUMENT

The purpose of a trademark is to identify the source of a product. *See Two Pesos v. Taco Cabana, Inc.,* 505 U.S. 763, 768 (1992). The mark GOLDENBERRY identifies Volcano Produce's Cape Gooseberries to the consuming public.

It is conceded that the mark here at issue is neither fanciful, nor arbitrary. However, it is not merely descriptive, but rather is suggestive in nature. The frequently fuzzy distinctions separating descriptive and suggestive marks are absolutely vital to their correct comprehension.

The proper categorization of a mark is, of course, a question of fact. *E.T. Browne Drug Co. v. Cococare Prods.,* 538 F.3d 185, 192 (3d Cir. 2009); *see also Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 118 (1st Cir. 2006). Moreover, a suggestive mark also can employ terms that relate to a product's characteristic(s) or intended use(s). However, the difference between a descriptive mark and a suggestive mark, at least in theory, is that the consumer has to engage in a mental leap in order to fathom the relationship between the

---

[1] As the prosecution history of this file clearly demonstrates, the Examiner has vacillated on grounds and rationales for refusal. First, according to the Examiner, the mark in question was deemed a varietal; then, following Applicant's Response, it was not. Initially (after Applicant's arguments and submission) there was no rejection based on alleged descriptiveness; then, there was. Inasmuch as the language set forth in the Examiner's prior Office Actions seemed also to leave the door ajar for potential future rejection on ground of genericness, Applicant wished to avoid the consequences, and costs, of any further *volta faces* on the part of the Examiner.

suggestive mark and the product (or service). A suggestive mark, therefore, "requires the observer or listener to use imagination and perception so as to determine the nature of the goods." *Leelanau Wine Cellars v. Black & Red, Inc.,* 502 F.3d 504, at 513 n.3 (6th Cir. 2007).

For that reason, in *Playtex Products v. Georgia Pacific Corp.,* 390 F.3d 158 (2d Cir. 2004) (per Sotomayor, J.), the mark, "WET ONES," was held to be suggestive. The same result was obtained in the case of "WITE-OUT," in *BIC Corp. v. Far Eastern Source Corp.,* No. 99 Civ. 11385, 2000 U.S. Dist. LEXIS 18226, at *8 (S.D.N.Y. Dec. 19, 2000); *see also OBX-Stock v. Bicast, Inc.,* 558 F.3d 334, 340 (4th Cir. 2009) (referring to other examples of suggestive marks such as "L'EGGS" for pantyhose products and "GLASS DOCTOR" for window repair services). Other notable marks that have been deemed to be suggestive (not merely descriptive) are MICROSOFT (for software for microcomputers) and NETSCAPE (for software which allows one to traverse the "landscape" of the internet).

Applicant coined its mark as a compound word, namely, GOLDENBERRY, to help further distinguish its mark. Moreover, the mark is used by Applicant as an adjective, not a noun.

The Examiner's opposing argument tends to lose sight of the fact that, as Applicant has explained, there are other many yellow berries, some of which are edible, and others not. Telling consumers, for example, that a produce item is a CRIMSONAPPLE fails to tell the consumer what kind of apple is being vended. Is it a "Delicious," an "Empire," a "McIntosh," a "Cortland," a "Rome," or a "Pink Lady" apple, all of which are red? The variety or type of fruit is not known, but the connection the consumer makes is between the product and its particular source or origin.

As to the Examiner's point regarding the Applicant's packaging, "Cape Gooseberry" and "Physalis Peruviana" are the generic and scientific names, respectively, for the fruit product in question. The GOLDENBERRY name and mark, however, is Applicant Volcano's brand for this particular produce product.

In Section B of the Examiner's Brief, the Examiner appears to go to great lengths to apprise the Board of a panoply of names for this type of fruit, namely, golden berry, golden berry, pichu berry, Peruvian cherry, Inca berry, ground berry, goose berry, Cape Gooseberry, "Amour en Cage" (Love in a Cage), etc. It should be patently obvious from this laundry list that, with so many monikers, no one name (apart from the generic and scientific names mentioned above) should be viewed as merely descriptive.

Moreover, as one of the tabloid articles which the Examiner seems to hang his hat on states: "Fresh goldenberries aren't common outside South Americas, but the dried variety is available at most supermarkets." (Emphasis added.) If the American consuming public is not that familiar with the product, the question next arises as to how, then, can the Applicant's brand be merely descriptive to consumers for the produce in question?

Indeed, the Examiner can cite to one tabloid or 10 such publications; yet, the undoubtedly authoritative agency, the U.S.D.A., does not officially recognize, or even mention, the name GOLDENBERRY. Surely, the U.S.D.A. would be cognizant of the descriptive name of the gooseberry if one existed. Furthermore, the off-the-cuff opinions expressed in such casual publications should hardly be deemed a substitute for the imprimatur of the U.S. government.

While the Examiner's collection of non-peer reviewed, casual, and homey written pieces admittedly carry some small measure of weight, the Board will have to decide if, in the final analysis, they outweigh the sagacity of the U.S. government agency which holds the

unquestionable experience and relevant expertise in this area. Or, to formulate the question another way, is it merely a tally of the tabloids that shall carry the day here?

In carrying out its important work, the USPTO engages in a fair amount of legal interpretation. To be sure, in deciding whether to grant or deny trademark registration to a given mark, USPTO must look to the federal law (*e.g.,* the Lanham Trademark Act). However, in many respects, the Lanham Act is far from clear, and its requirements are susceptible to generous and liberal interpretation.

Just as federal courts ought to defer to USPTO in the context of trademark disputes, so, too, the USPTO should defer to other federal agencies in situations where, as here, it is eminently reasonable and appropriate to do so.

Ironically, the USDA traces its origins back to the creation, in 1839, of the Agricultural Division within the Patent Office. Only later was an independent Department of Agriculture established by President Abraham Lincoln in 1862.

Returning to the present appeal, neither the suppositions of the Examiner, nor the gossamer wings of tabloid pages should be allowed to serve as a substitute for the agricultural oracle that is the USDA. Stated otherwise, if the USDA - - the competent U.S. government agency having expertise in plants, produce, fruits, vegetables, etc. - - does not recognize GOLDENBERRY as the descriptive name for the fruit, should that not, *ipso facto,* end the inquiry for USPTO? Applicant respectfully posits that the answer to that query is decidedly in the affirmative.

(IV.) CONCLUSION

Essentially based upon the discussion and analysis set forth, *supra*, Applicant, Volcano Produce, Inc., hereby respectfully submits that the Board ought to reverse the Examiner and allow registration of the Applicant's mark, GOLDENBERRY.

Dated: Miami, FL
September 13, 2016

Respectfully submitted,

HENKEL & COHEN, P.A.
Counsel for Applicant,
Volcano Produce, Inc.,
a Nevada corporation
18001 Old Cutler Road, Suite 600
Miami, FL 33157
Telephone (305)971-9474
Facsimile (305)971-9479

By: /s/ Ira Cohen, Esq.
IRA COHEN, ESQ.
Fla. Bar No. 0359882

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing document to be served on the Commissioner for Trademarks, TTAB, USPTO, 2900 Crystal Drive, Arlington, VA 22202-3513, by electronic filing (ESTTA) on this 13th day of September, 2016.

HENKEL & COHEN, P.A.
Counsel for Applicant,
Volcano Produce, Inc.,
a Nevada corporation
18001 Old Cutler Road, Suite 600
Miami, FL 33157
Telephone (305)971-9474
Facsimile (305)971-9479

By: /s/ Ira Cohen, Esq.
IRA COHEN, ESQ.
Fla. Bar No. 0359882